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In the Supreme Court of the United States

Supreme Court, U. S.
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CHARLES ELMORE CROPLEY
CLERK

OCTOBER TERM, 1940.

SCHRIBER-SCHROTH COMPANY,
Petitioner,
vs.
THE CLEVELAND TRUST COMPANY,
CHRYSLER CORPORATION,
Respondents.
No. 9.

ABERDEEN MOTOR SUPPLY COMPANY,
Petitioner,
vs.
THE CLEVELAND TRUST COMPANY,
CHRYSLER CORPORATION,
Respondents.
No. 10.

F. E. ROWE SALES COMPANY,
Petitioner,
vs.
THE CLEVELAND TRUST COMPANY,
CHRYSLER CORPORATION,
Respondents.
No. 11.

MOTION BY PLAINTIFFS (RESPONDENTS) (I) TO REMAND THESE CAUSES TO THE TRIAL COURT WITH DIRECTIONS TO REOPEN AND ADDUCE ADDITIONAL EVIDENCE AND TO CONDUCT THE PROPER PROCEEDINGS AS A RESULT THEREOF AND CONTINGENT THEREON AND (II) IN THE ALTERNATIVE, IN CASE THE MOTION (I) IS DENIED, TO REMAND THE CAUSES TO THE DISTRICT COURT TO RULE UPON THE QUESTION OF WHAT IT WAS THAT JARDINE ABANDONED IN CANCELLING THE INTERFERENCE COUNTS, MEMORANDUM ON THE MOTION AND AFFIDAVIT OF E. D. WATTS.

ARTHUR C. DENISON,
F. O. RICHEY,
WM. C. MCCOY,
MILTON TIBBETTS,
Counsel and Solicitors for Respondents.

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Now Come the plaintiffs (respondents) and move this Court (I) for an Order remanding these causes to the trial

* (In the event that their (the petitioners') Petition for Rehearing, filed herewith, is denied.)

court with directions to that court and to the Court of Appeals to reopen the causes and take evidence submitted upon the questions presented hereinbelow with appropriate proceedings in the causes with relation to those questions after the adducing of the evidence:

(1) What was it that Jardine abandoned when he cancelled the interference claims, particularly Claim 18 (19 E)?

(2) What construction was given those claims when they were made, retained and cancelled by Jardine?

(II) In case the above Motion is denied, and in the alternative thereto, the plaintiffs move that the causes be remanded to the District Court for the court's ruling on the above questions on the present record for the reason that the question upon which this Court based its decision had never been decided by any court below.

A. C. DENISON,
F. O. RICHEY,
WM. C. MCCOY,
MILTON TIBBETTS,
Counsel and Solicitors for Respondents.

MEMORANDUM ON THE MOTION.

As the case now stands the following propositions are true:

(1) The thing this Court said Jardine abandoned was not the thing that Jardine abandoned, but different therefrom.

(2) The question decided here was never decided by any court below; it was not pleaded, no issue was made up on it, it was not presented for consideration, no evidence was submitted or received on it, and it was not considered or decided by any court below; controlling evidence is available.

I.

(1) In its opinion in this cause this Court said (p. 9):

> "But the amended and cancelled claims are to be read in the light of the specifications."

While this is true of the ordinary case, such as the claims and specifications of the patent, it is not true of a count of an interference, such as claim 18 (19 E) for the reason that the count of an interference must (A) be read *in the light of the specifications of all the parties involved in the interference,* on the one hand, and, on the other hand, (B) as a legal proposition is given the broadest construction that its language will bear.

(A) The first proposition is self-evident. In the instant case there were five parties in the interference (R. pp. 811 and 812). It is self-evident that in order for the count to be made by each of the five parties to the interference, it must be given such a construction that it will read on the disclosures of each. Now, this Court gave the count such a construction that there was included in it the following two features (p. 9 of this Court's opinion):

(a) "retraction of the skirt from the bosses," and

(b) "balanced skirt flexibility."

If these limitations (a) and (b) were construed into this claim it would not describe the disclosures of certain parties to the interference. It follows that the thing that was abandoned by Jardine was a claim that would read on the disclosures of all of the parties to the interference. Therefore, the claim that was abandoned was a claim without limitations (a) and (b) in it.

(B) As we have said, it is an inflexible rule in the Patent Office that a count to an interference will be given the broadest construction that its language will bear. This rule is stated by the Court of Appeals of the District of Columbia in *Hewlett v. Steinberger,* 1913 Commissioner's Decisions, page 372, as follows:

> "We fully agree with the finding of the Commissioner that the corrugations of Steinberger, being properly positioned, perform and were intended to perform substantially the same function of the so-called 'flanges' and 'collars' of the issue. The terms are therefore synonymous, as used in this record. *This conclusion recognizes the rule that claims should be given the broadest interpretation consistent with the terms.* (*Lindmark v. Hodgkinson,* C. D., 1908, 540; 137 O. G., 228; 31 App. D. C., 612; *Viele v. Cummings,* C. D., 1908, 362; 134 O. G., 777; 30 App. D. C., 455; *Miel v. Young,* C. D., 1907, 561; 128 O. G., 2532; 29 App. D. C., 481.)" (Emphasis ours throughout unless otherwise indicated.)

The rule has been followed for years, was followed during the Jardine interferences, and is still followed.

This rule was applied in interpreting claim 18 (19 E) in the Patent Office and, of course, under this interpretation did not include features (a) and (b). When this Court construed features (a) and (b) into claim 18 (19 E) it made something that had not been before the Patent Office, had not been in the Jardine application, had not been made by Jardine and had not been cancelled or abandoned by Jardine.

We have filed herewith an affidavit of Mr. B. D. Watts who was in charge of the Jardine application and the interferences in which it was involved and to which is attached the drawings of two of the parties to the interference. From these drawings it is apparent that neither of the parties to the interference, Long or Spillman, could have made the count 18 (19 E), as this Court has construed it, because neither has features (a) or (b). This is explained more in detail in the affidavit of Mr. Watts attached. The same thing is true of the Hartog disclosure which is shown at page 727 of the record and is explained by Mr. Watts.

It results that this Court's decision is, therefore, predicated upon an error and that the Jardine claims have been invalidated upon an erroneous presumption. It also appears that if given an opportunity we can show that this is true.

What we have said about the claim 18 (19 E) applies to all the interference counts or claims with some immaterial variations of the facts. The same legal principle applies to all. The broadest interpretation that the language of the claims would bear was given the counts under the rule in *Hewlett v. Steinberger, supra,* so that when the claims were made, prosecuted, cancelled and abandoned by Jardine, such was the interpretation of the claims and *to construe anything in them now which narrowed them over that interpretation would be to hold that Jardine abandoned something that he did not abandon.* The immaterial variations in fact would be due to the variation in parties in the various interferences.

In the comparison of the cancelled claims and the claims in suit this Court appears to have overlooked the fact that the claims in suit recite the bosses and the location of the bosses in the webs, structure not in any of the cancelled claims. This structure, by well established authority, cannot be read into any of the cancelled claims (*McCarty v. Lehigh,* 160 U. S. 110, 116). Unless this struc-

ture is read into the cancelled claims the patented claims would be narrower than the cancelled claims notwithstanding everything that has been said by the Court in a comparison of the cancelled and patented claims. This feature of structure is most important as is clear from the opinion of the Court of Appeals (top of page 9 of Supplement to Petitioners' Brief in this cause) and from the record (R. pp. 37-39). Even if no heed was to be paid to the rule in *McCarty v. Lehigh*, the cancelled claims could not be interpreted to include this feature because such pistons as Spillman, for example, do not disclose this feature of structure. Spillman's webs 18 do not have the bosses in them.

(2) The defense that Jardine has abandoned in the Patent Office the subject-matter of his claims in suit without the term "flexible" in them was never—

Pleaded,

Placed in issue or issue joined thereon,

No evidence was ever submitted or received on the question except what incidentally crept into the record in connection with other questions,

The evidence in the record is insufficient for the purpose of deciding the question; there is controlling evidence not before the Court,

The question was never argued, briefed, presented to or considered by the Master, the District Judge, or the Court of Appeals.

It was never decided by any of these tribunals.

In fact, we cannot find where the question was ever raised until this Court voluntarily raised it in its consideration of this case.

It results that the Court has decided a question predicated upon an erroneous assumption which was never pleaded, placed in issue or considered below. We have shown by the affidavit of Mr. Watts that evidence upon the question is available and that if that evidence were considered, the views of this Court must be reversed.

We recognize that it was defendants' burden to raise this issue and to present evidence on the question and ask for a ruling on the same and, not having done so, it is improper to raise the question in this Court. Nevertheless, since this Court has itself raised the question, we think that it should not be decided until evidence has been submitted to the Court upon which to arrive at a correct decision. It goes without saying that we also assume that this being a reviewing Court, the question ought to be considered and ruled upon by the courts below before this Court rules upon it.

We further submit that we have made enough showing through the affidavit of Mr. Watts to show that there must be a reversal of this Court's decision on this question and, therefore, on the entire case.

We do not submit the interference records at this time because they are voluminous and include the applications of all the parties to the interference. These, of course, can be submitted and, if this Court thinks it is necessary, we shall submit them, though we think in the interest of brevity the showing through the affidavit of Mr. Watts and the drawings attached thereto is sufficient to show the propriety of granting this Motion. The interference records are public records in the Patent Office and, as such, are available to this Court.

II.

As we have said, the question of whether or not Jardine abandoned the subject-matter of the interference counts and particularly claim 18 (19 E) as interpreted by this Court, was never presented to or decided by any court below. The specific question decided by this Court, i.e., that the Jardine patented claims 1, 8 and 11 were invalid on the grounds that resort could not be had to the specification to construe the webs as flexible because a claim so construed had been made and abandoned, was never

pleaded, presented to, or decided by any court below. In fact, we cannot find where it was ever presented to any court. It seems to have been raised for the first time by this Court in its decision.

We need not cite to this Court the fact that this Court is a reviewing Court and that in the administration of justice its ministrations are limited to reviewing and ruling. All we need cite to this Court is the fundamental principle of the administration of justice which requires that any question decided by a reviewing Court must have been placed in issue below, submitted to proof, and decided by the lower tribunals.

Therefore, even if the first portion of this Motion is not allowed, and the parties are not to be permitted to adduce evidence such as the interference records on the question, there ought to be a remand to permit the lower Courts to decide the question. We submit that in view of the rules stated in *Hewlett v. Steinberger, supra,* the lower courts must come to a different decision from this Court and that, therefore, the granting of the Motion would be controlling on the decision of the case. As the matter now stands the plaintiffs never even had an occasion to call the rule in *Hewlett v. Steinberger* to the attention of this or any other Court because, as we say, the question decided was never, as far as we have been able to find out, presented to or considered in this litigation until this Court took it up and made it the basis of its decision.

A. C. Denison,
F. O. Richey,
Wm. C. McCoy,
Milton Tibbetts,
Counsel and Solicitors for Respondents.

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AFFIDAVIT OF B. D. WATTS.

STATE OF OHIO,
COUNTY OF CUYAHOGA, SS.:

B. D. WATTS, being duly sworn, deposes and says:

I am the B. D. Watts who was appointed solicitor of the Jardine patent, June 14th, 1920 (R. p. 759). Thereafter I conducted the prosecution of the Jardine application and supervised the conduct of the interferences in which the Jardine application was involved, including Interference No. 49,578, involving the count or claim 18 (19 E)

(R. p. 790) referred to by the Supreme Court in its recent opinion in the above entitled causes. The declaration of the interference appears at pages 811 to 812 of the record and, as shown, involved the applications of five people, i.e., Day, Spillman, Hartog, Jardine and Long.

I entered the employ of the United States Patent Office as Assistant Examiner in June or July 1915, and served as Assistant Examiner until September, 1917. Since then I have been employed as a patent attorney in soliciting patents, conducting interferences, etc., and am familiar with the Patent Office practice in declaring and conducting interferences as well as prosecuting patent applications.

Ordinarily a claim, such as claim 18 (19 E), called a count in an interference, is selected from an application of one of the parties involved in the interference and is suggested to the other parties. Occasionally, however, the count is framed or written by the Examiner and suggested to the various parties who become participants in the interference. On examining the records in Interference No. 49,578, I find that claim 18 (19 E), the interference count, did not originate in any application of any of the five parties whom I have named, from which I conclude that it was framed and suggested by the Examiner.

At the time a claim is suggested, the Patent Office takes the view that the claim is entitled to the broadest construction that its language will bear and that it is disclosed in the specifications and reads upon the drawings of each of the parties to whom it is suggested. Each party who makes the claim makes it with the understanding that it reads upon his drawing and is disclosed in his specification. When the claim is made by two or more of the parties to whom it is suggested, the interference is declared by the Patent Office on the theory that the claim is given the broadest construction which its language will bear and that it is described in the specification of each of those who make it and reads upon the drawings of each of those who make it.

From my own personal knowledge I know that this procedure was followed in the declaration of the Interference No. 49,578. During the early proceedings in the interference I became familiar with the pistons disclosed in the applications of each of the parties Day, Spillman, Hartog, Jardine and Long involved in the interference and was aware of the nature of these structures all during the proceedings in the interference. I attach hereto a copy of the drawing of the application of Long, Serial No. 317,273, which was involved in this Interference No. 49,578, which drawing illustrates the Long piston that was described in Long's said application. I also attach hereto a copy of the drawing of the application of Spillman, Serial No. 484,124 which was involved in that Interference No. 49,578, which drawing illustrates the Spillman piston that was described in Spillman's said application.

An examination of these Long and Spillman pistons shows that neither one of them illustrates a piston in which there is either "retraction of the skirt from the bosses" or "balanced skirt flexibility." An examination of the drawing of the Long piston shows that the bosses are rigid with and flush with the skirt, so that there is neither retraction of the bosses from the skirt nor of the skirt from the bosses. A further examination shows that a portion of the Long skirt is not only not flexible, but provisions are made for making it rigid. The portions 8 of the skirt are not only rigidly connected to the bosses, but the two bosses are connected together by a thwart 13 to insure rigidity in the skirt in the direction of the axes of the bosses, so not only is there not balanced skirt flexibility in this Long piston, but there is a part of the skirt which is not flexible at all.

The Spillman bosses are flush with and rigid with a portion of the skirt, just as in Long. In Spillman the portion of the skirt above the slots 15 and 16 is rigid across each diameter, so that Spillman has a portion of the skirt

which is rigid and therefore cannot have "balanced skirt flexibility."

When the count was made by Jardine, when it was retained in the Jardine application and when it was cancelled, it was understood by all parties involved, including Jardine and the Patent Office, that the count bore the construction, and only the construction, under which it described the pistons of all of the parties involved, including the Long and Spillman pistons. It would not have been possible to give the count the construction which this Court has given it and have it read upon either the Long or Spillman pistons involved in the aforesaid interference.

I have read the opinion of this Court and particularly the part contained in next to the last paragraph thereof and am familiar with the construction given this claim 18 (19 E) when it was made in the Jardine application, when it was retained therein and when it was cancelled, and I know that the claim that was abandoned and the subject-matter that was abandoned with it was a different thing from the claim as construed by this Court in its opinion, and the subject-matter included in the claim as construed by this Court. In other words, I know that the thing that was abandoned was not the thing that this Court has said in its opinion was abandoned.

I believe that if the cause is reopened and this evidence, including the interference record and the applications of the other parties to the interference are included in the record, all of this will be established and this Court will then see that it has decided the case upon the theory that Jardine abandoned something which is very different from the thing that he did abandon.

B. D. Watts.

Subscribed and sworn to before me this 30th day of December, 1940.

Florence Kopsky,

(Notarial Seal) *Notary Public.*

My commission expires May 5, 1942.

156/102 C

Fig. 1.

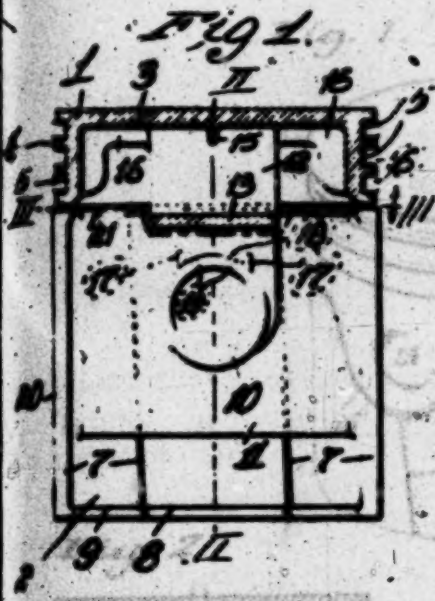

Fig. 2.

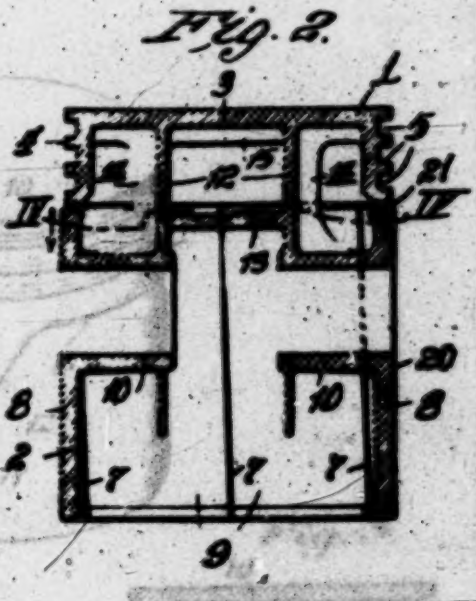

Fig. 3.

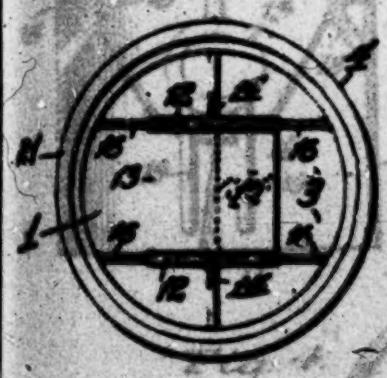

Fig. 4.

Inventor
Elmer C. Lang
By H. G. Gilbert